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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/621,234  
Filing Date: July 20, 2000  
Appellant(s): HENSHAW ET AL.

Scott R. Pundsack

For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 12/04/8 appealing from the Office action  
mailed 11/01/07.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

See supplemental letter filed on 6/30/06.

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

11/049,988, and 11/059,403, an appeal brief has not been filed yet.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments after Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

Application 08/690,045's record.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 15-18 and 24 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Claims 1 and 9 in application 08/690,045, now US 5,783,083, both have the following proviso:

**the improvement comprising:**

**each said header having said fibers spaced apart by a flexible**

**support means having a thickness corresponding to a desired lateral**

**spacing between adjacent fibers, said support means extending over only each terminal portion of said fibers near their ends, so as to maintain said ends in closely-paced apart relationship.**

The proviso was added by amendment on January 12, 1998, along with extensive arguments of how the newly added limitation distinguishes the claimed invention over the prior art cited by the Examiner. At p. 7 of that amendment, for instance, the applicant's refer to the "flexible support means having a thickness corresponding to a desired lateral spacing between adjacent fibers" as the "second essential element" which gave their invention a clear advantage over the prior art.

The record is clear, therefore, that the applicants surrendered broader coverage when they added the proviso to the claims in order to obtain a patent. Claims 15-18 and 24 in this reissue lack that limitation and thus they are rejected under 35 USC 251 as involving an improper attempt to recapture surrendered subject matter. See MPEP 1412.02.

It is noted that claim 15 in this reissue includes limitations narrowing the scope of the claims as follow: a pump; and

**"at least a portion of the membranes spaced apart from adjacent membranes by the potting material to a center-to-center distance in the range from 1.2 to 5 times the outside diameter of the membranes",**

these limitations were not recited in claims 1 and 9 of 08/690,045, now US 5,783,083. Nevertheless, claims 15-18 and 24 in this reissue are missing the aforementioned

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proviso, which was "an aspect to germane to a prior art rejection". Therefore, the claims are "broader in scope in some aspects and narrower in others".

#### (10) Response to Arguments

Applicants refer to the three steps test for recapture (see MPEP 1402.02), and

acknowledges that claims 15-18, and 24 are **broader in some aspects** than the limitations of claims 1 and 9 of independent claims in the patent (US 5,783,083), although they are narrower in other aspects.

The Examiner disagree with applicants statement that the membrane spacing by the potted material replaces the limitation of spacing by a flexible support means. The flexible support means as defined in the specification refers to a second additional element other than the conventional potting material.

The Flexible support means are defined in the specification as "flexible planar support means, such as strips or cards, which can be formed into a loose roll glued to the fiber ends (se patent 5,783,083, column 1 2, last paragraph, bridging column 13).

As to the second test (to determine recapture), the broader aspects, such as "fiber spacing range, these limitation was to part of the claims application filed in the corresponding patent application 08/689,045.

Regarding the third step, claims 15-18, and 24 in this reissue are missing the aforementioned proviso, which was "an aspect to germane to a prior art rejection". Therefore, the claims are broader in an aspect and narrower in another aspect.

A response to whether Applicants are claiming an additional invention or embodiment (overlooked aspects of the disclosed invention). To avoid recapture the claims in the new embodiment need to be directed to a "separate invention"; however, claims 15-18 and 24 are directed to the same invention or "system comprising a hollow fiber membrane system within a no pressurized reservoir", and the limitation "flexible support means..." is **relevant** to the invention of claims 15-18 and 24.

Hester Industries Inc. v. stein Inc. [Hester, 142F. 3d at 1482-83, 46 USPQ2d 1649-50); and

B.E. Meyers & Co. v. United States, 56 USPQ 2d 1110 (US CtFedClis 2000).

Furthermore, the new claim limitation e.g. spacing between potter membrane is old in the art as evidenced in Patent US 5,248,426 cited in the record.

#### (11) Related Proceedings (s) Appendix

No decision rendered by a court or Board is identified by the examiner in the Related

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Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.  
Respectfully submitted,

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